

## REMARKS

Upon entry of this Amendment, claims 1, 4-8, and 10-19 will be pending. Claims 2, 3, and 9 are canceled and claims 1, 4, 10, 11, 15 and 16 are amended to more particularly point out and distinctly claim Applicants' invention.

Claims 1, 4 and 15 are amended to reflect the elected subject matter in which  $n = 1$ . For clarity, the generic structure of formula I of claims 1 and 15 has been amended to depict the subject ring as 5-membered structure and to delete reference to the parameter " $n$ ." In view of this amendment to claim 1, claim 4 is amended to delete the recitation that  $n = 1$ . Claim 1 is also amended to delete the recitation that  $R_3$  is  $\text{NHCO}_2\text{R}_4$  or  $\text{NHCO}_2\text{R}_4$ , to conform with amendments made during prosecution of co-pending divisional Application Serial No. 11/931,948, which is also before Examiner Balasubramanian.

Claim 10 is amended to recite the compound 1-(4-Cyano-2-ethyl-3-(trifluoromethyl)phenyl-1-carbamoyl)-3-hydroxy-pyrrolidine-2-carboxylic acid rather than the methyl ester thereof. Support for this amendment is found, *inter alia*, at page 49, lines 5-10 of the specification as filed.

Claims 11 and 16 have been amended to correct a typographical error, replacing the phrase "the a" with the article "a."

No new matter is added by these amendments and Applicants reserve the right to pursue the subject matter of the withdrawn, canceled, amended claims in one or more divisional or continuation applications.

### **I. The Rejection Under 35 USC § 112, 1<sup>st</sup> Paragraph Should be Withdrawn**

Claim 10, as well as claims 11-14 dependent thereon, are rejected under § 112, 1<sup>st</sup> paragraph, for alleged noncompliance with the written description requirement. In particular, the Examiner has alleged that the first compound recited in claim, 10 (1-(4-Cyano-2-ethyl-3-(trifluoromethyl)phenyl-1-carbamoyl)-3-hydroxy-pyrrolidine-2-carboxylic acid methyl ester), is not supported by the specification as filed. Although the corresponding carboxylic acid is clearly described by the specification as filed (*see e.g.* page 49, lines 5-10 and page 2 of the Office Action), the Examiner has alleged that the methyl ester is not supported by the specification as filed. Applicants do not necessarily agree but, to expedite allowance of the pending claims,

claim 10 is amended as indicated above, to recite the free acid. Applicants therefore respectfully submit that the instant claims, as amended, are fully supported by the application as filed. Accordingly, Applicants respectfully request that the rejection of claim 10, and claims 11-14 dependent thereon, under 35 USC § 112, first paragraph, be withdrawn.

## **II. Objections Alleging Recitation of Non-Elected Subject Matter Should be Withdrawn**

Claims 1, 4-8, and 15-19 are objected to as allegedly reciting non-elected subject matter. In response, Applicants respectfully submit that the compounds of Formula I of independent claims 1 and 15 are those in which  $n = 1$ .

Applicants therefore respectfully submit that the instant claims, as amended, do not encompass non-elected subject matter. Accordingly, Applicants respectfully request that the Examiner's objection to claims 1, 4-8 and 15-19 as reciting non-elected subject matter be withdrawn.

### Conclusion

Applicants respectfully request that the above amendments and remarks be entered and made of record in the instant application. Applicants submit that all the rejections presented in the Office Action have either been overcome or obviated and therefore Applicants respectfully request that the rejection of claims 10-14 under 35 USC § 112, first paragraph, and the objection to claims 1, 4-8 and 10-19 as reciting non-elected subject matter, be withdrawn.

Applicants submit that the application is now in condition for allowance. Should the Examiner not agree with Applicants' position, then Applicants respectfully request a personal or telephonic interview with the Examiner to discuss any remaining issues so as to expedite prosecution and eventual allowance of Applicants' claims.

It is believed that no fee is due in connection with this amendment, other than the fees required for the Petition for an Extension of Time, and the Notice of Appeal. Should the Patent Office determine that any fee is due, please charge the required amount to Dechert LLP Deposit Account No. 50-2778.

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Respectfully submitted,

  
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